



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventors: Elizabeth F. Churchill et al.

Appln. No.: 09/391,069

Confirm. No.: 8020

Filed: September 7, 1999

Title: ANCHORED CONVERSATIONS: ADHESIVE,
IN-CONTEXT, VIRTUAL DISCUSSION
FORUMS

PATENT APPLICATION

Art Unit: 2155

Examiner: B. Barot

Customer No. 23910

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 21, 2005.

Michelle McAnern Calavita

Michelle McAnern Calavita

Signature Date: July 21, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

These Remarks are in reply to the Final Office Action mailed February 23, 2005 (hereafter, "Final Office Action") and in reply to the Advisory Action Before the Filing of an Appeal Brief mailed July 7, 2005. Claims 1-27, 33-35, 47 and 48 were pending in the Application prior to the outstanding Final Office Action. The Final Office Action rejected claims 1-27, 33-35, 47 and 48.

Claims 1-3, 5-10 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado (U.S. Patent No. 6,542,165; hereafter, "*Ohkado*"). Claims 22-25, 27, and 48 were rejected for similar reasons without any substantive analysis beyond that given for claims 1-3, 5-10 and 15-20. Claims 4 and 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of England (U.S. Patent No. 6,144,991; hereafter, "*England*"). Claims 26 and 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of Gutfreund et

al. (U.S. Patent No. 6,192,394; hereafter, “*Gutfreund*”). Claims 21 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohkado* in view of Varma et al.. (U.S. Patent No. 6,564,246; hereafter, “*Varma*”).

The present invention discloses a system whereby users are able to engage in conversations anchored to locations within commonly viewed files. These files are viewed from their native applications on the system of each user. The claimed system is especially efficient as it utilizes the file viewing capacities of applications associated with the file. For example, a Microsoft Excel document could be viewed from the Microsoft Excel application on the user’s system.

Ohkado, which discloses a system of collaborative image generation programs, does not disclose or suggest the features of the claimed invention. *Ohkado* does not disclose the collective accessing and conversing about files. The annotations or windows anchored in context within a document, as disclosed by *Ohkado*, cannot be equated with a conversation. Rather *Ohkado* discloses a system for highlighting physical sections of a viewing window so that the sections can be viewed on other systems. User’s ability to update annotations can in no manner be equated with a conversation such as the anchored conversations disclosed by Applicants. A conversation is, for purposes of Applicants’ disclosures, an ongoing, multi-directional, sequential exchange of streaming messages. Moreover, according to Applicant’s disclosures and in marked contrast with *Ohkado*, past messages are saved in a persistent manner providing a history of the conversation. By contrast, *Ohkado* discloses annotations that are single images that can be modified in final form only, are not streaming, and do not provide a history of the markings. Therefore, the current disclosures differ from *Ohkado* in communication technique, implementation, and user experience.

Specifically, contrary to the suggestion of the Final Office Action, and unlike Applicants’ claim 1, *Ohkado* does not disclose an application configured to access the artifact, wherein the application is *associated with the file type*. The first cited excerpt from *Ohkado* (fig. 1) discloses a block diagram showing a hardware configuration suitable for operation of the invention, consisting of a system, apparatus, and method of relating annotation data to an application window. The second cited excerpt from *Ohkado* (fig. 2) discloses a block diagram of components suitable for operation of the invention, consisting of a system, apparatus, and method of relating annotation data to an application window. The third cited excerpt from *Ohkado* (fig. 3) discloses a diagram showing an example of a user interface in the preferred embodiment of the invention, consisting of a system,

apparatus, and method of relating annotation data to an application window. The fourth cited excerpt from *Ohkado* (col. 9, line 16) discloses that the subject application is an application which is a subject of annotation.

The fifth and final cited excerpt from *Ohkado* (col. 12, lines 45-50) discloses that, after a session with the other computer is established, and after a desired application is selected from the list of applications, “the kind of application, the file name used or to be used... and the window size... are obtained in the main station side and transmitted to the other computer system.” This disclosure therefore relates to selection an application type, file *name*, and window size to be used by the remotely located terminal displaying a corresponding transparent window. Therefore no disclosure whatsoever appears regarding an application that is *itself* configured to access an artifact, said application being *itself* associated with the file type. Despite the Final Office Action’s attempted conflation of file *name* and file *type* in its reference (p. 10, para. 7) to “file name/type,” it is well known that the two concepts are quite distinct and can in no way be equated with each other. The application of *Ohkado* does not perform any of the recited features (annotation, etc.)

Similarly, the annotations of *Ohkado* are not associated with the files themselves, but rather the raw images that are transmitted, as indicated in col 3 ln. 20-24 “a step of sending image data of said application window”. The Final Office Action’s suggestion that *Ohkado* (col. 12, lines 45-50) discloses these elements is not supported by the cited disclosures. Specifically, the Final Office Action notes that *Ohkado* (col. 12, lines 45-50) “discloses that the application and file to be used in collaboration is selected prior to establishing the collaboration session.” However, these disclosures do not at all suggest or teach annotations that are associated with the files themselves.

Similarly, *Ohkado* does not disclose an artifact comprising a file having a file type. The artifacts of *Ohkado* are raw image data, rather than files associated with particular applications. The approach of *Ohkado* is distinctly inferior as the disclosed text communications are not associated with artifacts documents, but rather raw images highlighted within a user’s desktop. Furthermore, *Ohkado* depends on the capacity of the receiving client to receive raw image files.

Claim 3, in addition to the limitations of claim 1, additionally recites that the conversation element is configured to allow access to sections of the artifact outside the anchor. *Ohkado* is manifestly deficient of this feature. The section of *Ohkado* cited by the Examiner (col. 12-13; no line numbers provided) discloses the drawing of an annotation in the transparent window, and the

collaboration with another terminal located in a remote location, not accessing sections of the file outside the shared space. Indeed the system of *Ohkado* cannot allow access to sections of the application outside the anchor, and teaches away from a system that does allow access to such sections of the application, because the system of *Ohkado*, rather than utilizing a shared chat space that is anchored to a section of a file, transmits raw graphical information to the other clients.

Claim 5 recites the creation of a recipient conversation having an anchor, application, and artifact that are equivalent to the artifact, anchor, and application the requesting conversation client. *Ohkado* fails to disclose or suggest this feature. Claim 1 recites that the artifact is a file having a file type. Thus claim 5, when taken with the limitations of claim 1, recites that the recipient conversation includes an artifact that is a file having a file type, equivalent to the one on the initiating conversation client.

However, the remote parties discussed in *Ohkado* *cannot* view an original or copy of the remote source file, as the system of *Ohkado* only transmits raw images from sections of the source file. As discussed in the cited section “a second display apparatus for displaying image data of said first application window”. Thus, it is impossible for a conversation recipient in *Ohkado* to have an artifact equivalent to the artifact of the requesting conversation client, as the system of *Ohkado* does not provide access to files, only to raw image data extracted from the file.

Regarding independent claim 48, the Final Office Action comments (page 6, last paragraph) that this claim does not teach or define any new limitations above claims 1-3, 5-10, 15-20 and therefore is rejected for similar reasons. Accordingly, we incorporate by reference our above arguments for the patentability of claim 1, and argue for similar reasons that claim 48 is also patentable. Additionally, contrary to the suggestion of the Final Office Action, independent claim 48, in addition to the patentable subject matter of the other independent claims, recites that communications are received by parties having access to the file. *Ohkado* is deficient of any mention of this feature and as discussed above, such functionality is incompatible with the system of *Ohkado*, as remote parties are only given access to image slices extracted from the application. For all these reasons, independent claim 48 is patentable.

Claims 4 and 11-14, 26 and 33-35, were rejected over *Ohkado* in view of *England*, *Gutfreund*, and *Varma* respectively. With respect to these rejections, including the rejection of independent claim 33, the Final Office Action cites no motivation to combine the references. The

Final Office Action provides a *benefit* for combining the references, but demonstrates no motivation, either explicit or implicit, in any of these references for combining them. Applicants disclose an inventive method for integrating a large number of components, and further disclose adjustments required of the components to provide the overall capability for the in-context, streaming communications of anchored conversations. These disclosures are not obvious and are patentable.

Regarding independent claim 47, the Final Office Action comments (page 10, 4th paragraph) that this claim does not teach or define any new limitations above claims 1-27, 33-35 and therefore is rejected for similar reasons. Accordingly, we incorporate by reference our above arguments for the patentability of claims 1-27 and 33-35, and argue for similar reasons that claim 48 is also patentable.

The references cited in the Final Office Action, including *Marsland*, and *Clark*, considered singly or in combination, fail to disclose all of the limitations of independent claims 1, 33, 47, and 48. Claims 2-27 and 34-35 each ultimately depend from one of the independent claims and are believed patentable for at least the same reasons as the independent claims and because of the additional limitations of these claims.

Accordingly, claims 1-27, 33-35, 47 and 48 are allowable.

Respectfully submitted,

Dated: 7/21/05

By: J. Steven Svoboda
J. Steven Svoboda
Registration No. 44,366

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Facsimile: (415) 362-2928
e-mail: jss@fdml.com